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10/518,400	01/19/2005	Gerald Payne	66307-329-7	8097

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EXAMINER
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WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3722

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,400	<b>Applicant(s)</b> PAYNE ET AL.	
	<b>Examiner</b> JAMILA WILLIAMS	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6-29-05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the security element at least partially embedded in the paper, as recited in claim 1; security element wholly embedded in the paper, as recited in claim 4; activatable security feature, recited in claim 14; elongated element exposed at windows, as recited in claim 5; elongated element wholly exposed across the full width of the paper, as recited in claim 6; adhesive as recited in claims 19,21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 19 is objected to because of the following informalities: there is a lack of antecedent basis for "the surface" in line 3 of the claim. Appropriate correction is required.

Claim 20 is objected to because of the following informalities: there is a lack of antecedent basis for "the region" in line 2 of the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-12,14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,217,307 to McClintock in view of 6,254,139 to Fresnel.

Regarding claim 1, McClintock discloses paper (column 5 line 10) having first and second opposing surfaces (figure 2), an elongated element (12) such that when a tearing force is applied to the elongated element a tearing force is applied to thereto, a

removable portion is separated from the rest of the paper (elongated element 12 forms a tear strip that is removed from the rest of the paper).

McClintock does not however disclose the security element having at least one verifiable authentication feature, the security element at least partially embedded with in the paper.

Fresnel teaches having a sheet having an elongated element characterized in that the element is a security element (Fresnel- 22 includes hologram 30) having at least one verifiable authenticating feature (Fresnel- column 8 lines 1-20) and being at least partially embedded with the paper (Fresnel- figure 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the security element of Fresnel with the paper of McClintock for the purpose of providing a more secure item.

Regarding claim 2, McClintock modified by Fresnel discloses the removable portion is the elongate element (McClintock- tear strip 12, Fresnel- figure 2,3).

Regarding claim 3, , McClintock modified by Fresnel discloses the removable portion comprises a section of the paper and the elongated element (McClintock- tear strip 12, Fresnel- figure 1,2 ).

Regarding claim 4, McClintock modified by Fresnel discloses the elongate element is wholly embedded in the paper (McClintock- figure 2 shows the elongate element 12 wholly embedded in paper)

Regarding claim 6, McClintock modified by Fresnel discloses one side of the elongate element is wholly exposed across the full width of the paper (looking at figure 1 of McClintock the elongated element is wholly exposed across the full width).

Regarding claim 7, McClintock modified by Fresnel discloses at least one line of perforations separating the removable portion from the rest of the paper (14,15 of McClintock).

Regarding claim 8, McClintock modified by Fresnel discloses the removable portion is an edge portion of the paper (McClintock- tab 13 of strip 12 is on the edge).

Regarding claim 9, McClintock modified by Fresnel discloses the removable portion comprises a middle section of the paper (McClintock- looking at figure 11 for example, strip 12 comprises a middle section of the paper).

Regarding claim 10, McClintock modified by Fresnel discloses the removable portion comprise legible indicia (McClintock- column 3 lines 40-42, column 8 lines 17-21).

Regarding claim 11, McClintock modified by Fresnel discloses the legible indicia comprises printed information (McClintock- column 3 lines 40-42, column 8 lines 17-21).

Regarding claim 12, wherein the legible indicia is formed from demetallised or metallised alphanumeric characters on the elongated element, the patentability of a product does not depend on the method of production. Product by Process claims are not limited to the manipulation of the recited steps only the structure implied by the steps. MPEP 2113.

Regarding claim 14, McClintock modified by Fresnel discloses the elongated element incorporates an activatable security feature (the examiner takes the position that the hologram of Fresnel which is connected to the tear strip of McClintock provides an activatable security feature).

Regarding claim 15, McClintock modified by Fresnel discloses the elongate security element comprises one or more of the same security features (figure 8 of Fresnel).

Regarding claim 16, McClintock modified by Fresnel discloses an end of the elongated element is enclosed in a tab (13 of McClintock) projecting from an edge of the paper.

Regarding claim 17, McClintock modified by Fresnel discloses an end of the elongate element is exposed in a cut out portion of an edge of the paper (tab 13 of McClintock provides this cut out portion).

Regarding claim 18, McClintock modified by Fresnel discloses a label made of paper (McClintock- column 5 lines 5-16).

Regarding claim 19, McClintock modified by Fresnel discloses a label further comprising adhesive applied to at least a portion of the second surface of the paper (McClintock- adhesive 18), such that when the label is adhered to the surface and a tearing force applied to the elongated element, a removable portion is separated from the rest of the label.

Regarding claim 20, McClintock modified by Fresnel discloses no adhesive is applied to the second surface in the region of the removable label portion (McClintock-tear strip 12 is without adhesive).

Regarding claim 21, McClintock modified by Fresnel discloses a low tack adhesive is applied to the second surface of the removable portion of the label, the adhesive being of a lower tack than the adhesive applied to other parts of the second surface of the paper (McClintock- column 6 lines 12-20 discloses having a permanent adhesive portion on the label and a removable adhesive on the upper portion of the label, the examiner takes the position that this upper portion of the label that is removable includes an adhesive of lower tack than the permanently adhesive part of the label).

Regarding claim 22, McClintock modified by Fresnel discloses packaging made of paper (McClintock figure 1 provides packaging for the container).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock in view of Fresnel and further in view of 5,895,075 to Edwards.

McClintock modified by Fresnel discloses all elements of the claims including having indicia in the form of code (Fresnel- column 8 lines 3-4). However, these references do not explicitly provide a clear teaching of the code being machine readable. Edwards teaches having a label with machine readable code on the removable portion (figure 2- machine readable code in form of bar code). It would have been obvious to one having ordinary skill in the art at the time the invention was made



to use the code of Edwards with the label of McClintock modified by Fresnel for the purpose of providing a machine readable label.

Claims 1,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock in view of 6,255,948 to Wolpert et al (hereinafter Wolpert).

Regarding claim 1, McClintock discloses paper (column 5 line 10) having first and second opposing surfaces (figure 2), an elongated element (12) such that when a tearing force is applied to the elongated element a tearing force is applied to thereto, a removable portion is separated from the rest of the paper (elongated element 12 forms a tear strip that is removed from the rest of the paper).

McClintock does not however disclose the security element having at least one verifiable authentication feature, the security element at least partially embedded with in the paper.

Wolpert teaches having a label with a security thread (column 4 lines 58-63, column 5 lines 14-21) at least partially embedded in the paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the security thread of Wolpert with the label of McClintock for the purpose of providing security features to the label.

Regarding claim 5, McClintock modified by Wolpert discloses the security thread can be woven into the label or item (column 5 lines 14-21). This would provide the windows of exposed security thread as recited in the claim.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 517-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Derris H Banks/  
Supervisory Patent Examiner, Art Unit 3725

/J. W./  
Examiner, Art Unit 3722

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